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EXAMINER

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Commissioner of Patents and Trademarks



**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/932,238
Filing Date: September 17, 1997
Appellant(s): Stan Torgovitsky

Stan Torgovitsky
For Appellant

MAILED
SEP 15 2000
GROUP 2800

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed July 12, 2000.

(1) *Real Party in Interest*

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

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(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

Claims 1, 43, 46, 49 and 52 have been amended subsequent to the final rejection.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on March 8, 2000 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-6 and 43-52 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Appellants' admitted prior art (Specification pages 7-10 and Figures 1-6B).

5,101,099

Funada et al

March 31, 1992.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 and 43-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 13; claim 43, line 10; and claim 52, line 9, "such" is indefinite.

In claims 46 and 49, the antecedent basis of "said corresponding light receiving element" on line 2, respectively, is unclear. It appears that "light receiving element" should be changed to "light receiving elements". Clarification and correction are required.

Claims 2-6, 44, 45, 47, 48, 50 and 51 are indefinite because they include the indefiniteness of the claims on which they depend.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 43-46, 48-50 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Funada et al 5,101,099 or the Appellants' admitted prior art (Specification pages 7-10 and Fig. 1-6B).

Funada et al disclose an image reading device comprising an image sensor portion (100) having a plurality of light receiving elements (121,122) arranged regularly facing a document (400) to be read out; and a thin film light source (20,241,242,243,244) arranged closely contacted on the document side for emitting light to the document, wherein the light source includes a plurality of light emission portions (243) each having a light emission area (245) smaller than each receiving portion of the light receiving elements (Figures 9 and 11), and opaque electrodes (244) function as a light

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blocking layer. There at least one light emission portion (243) with the light emission area (245) is substantially centered and aligned with respect to the corresponding light receiving element 121. The light blocking layer is positioned between the document and the light receiving elements. The Appellants' admitted prior art also disclose an image sensor device comprising a plurality of light receiving elements (1612) arranged regularly facing a document (1690) to be read out; and a thin film light source (1620) arranged closely contacted on the document side for emitting light to the document, wherein the light source includes a transparent electrode (1622), a light emission layer (1623), a plurality of light emission windows or light emission portions (1625), and an opaque electrode (1625). The opaque electrode includes a plurality of openings forming light emission portions and light blocking portions with each emission portion having an area smaller than each light receiving portion of the light receiving elements, wherein at least one of the light emission portions is substantially centered and aligned with the corresponding light receiving element (Figures 5-6B). The opaque electrode is disposed between the light receiving elements and the document.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-6, 47 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funada et al 5,101,099 or the Appellants' admitted prior art (Specification pages 7-10 and Figures 1-6B).

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Regarding claims 2, 4, 47 and 51, although Funada et al and/or the Appellants' admitted prior art fail to disclose an organic thin film (insulating layers) with separate organic thin film areas held between the transparent and opaque electrodes, the selection of a prefer material for component(s) of a device would have been a mere matter of obvious design choice to one of ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. The similar selection of the image sensor being cited in claim 4 would have been obvious for similar reasons set forth above.

Regarding claim 5, although Funada et al and/or the Appellants' admitted prior art fail to specify the colors of light emitted from the light source, using a light source with light of different colors to maximize responsivity of the receiving elements would have been obvious in the art. It would have been obvious to modify Funada et al or the admitted prior art accordingly in order to provide a more reliable reading output from the receiving elements.

Regarding claim 6, although Funada et al and/or the Appellants' admitted prior art fail to disclose an optical fiber collection member provided between the light source and the document, the use of optical fiber for conducting light in an image sensor is known in the art. It would have been obvious to modify Funada et al or the admitted prior art accordingly in order to minimize possible spurious response from unwanted light.

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Applicant's arguments filed August 6, 1999 have been fully considered but they are not persuasive.

With respect to Applicants' arguments, on page 8 of the remarks, regarding the feature of at least one light emission portion being substantially aligned with the corresponding light receiving element, it is noted that: Funada reference, at least Figure 4 shows that at least one light emission window or light emission portion 206 is substantially aligned with the corresponding light receiving element 101a (column 8, lines 2-3; and the Appellants' admitted prior art, Figure 3 shows that light being emitted from at least one light emission portions (fibers 1301) and at least one end of the fibers 1301 is substantially aligned with the corresponding light receiving element 1306. Similarly, at least one light emission portion or light emission window 1504, shows in Figure 4, is substantially aligned with the corresponding light receiving element 1502.

Accordingly, the rejection set forth above is proper.

(11) Response to Argument

This examiner's answer does not contain any new ground of rejection.

I) The brief, pages 7 and 8, argues that the amended claims 1, 43, 46, 49 and 52 (and their respective dependent claims 2-6, 44, 45, 47, 48, 50 and 51) are not indefinite within the meaning of 35 U.S.C. 112 second paragraph. This is found persuasive because the above identified claims have been amended to overcome the indefiniteness of the claims set forth in the final rejection dated January 7, 2000, paper no. 15.

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II) The brief, pages 8-11, argues that the prior art devices illustrated in Figures 1-6B does not disclose the claimed invention of claims 1, 3, 43-46, 48-50 and 52, in that the brief argues that the optical fiber array (1301 of Appellants' admitted prior art Fig. 2) do not emit light to the document (1390) but simply pass the reflected light from the document to the light receiving element array (1306) and so that not at least one of the optical fiber array is substantially aligned with the corresponding light receiving element (1306). This is found not persuasive because for the "reflected light from the document passes through the optical fiber array 1301 so that it is detected by the light receiving element 1306" (See specification pages 4, lines 15-17, Description of the related art) reflected light from the document must entering a receiving end of the fiber array and in turn must exiting/emerging/emitting from a transmitting end of the fiber array. As the light exiting the transmitting/emitting end of the fiber array, the light is emitted from the fiber array 1301. Thus, the operation/performance of the Appellants' admitted prior art is that the reflected light, from the document 1390, to be detected by the light receiving element 1306 must be entered and emitted by/from the optical fiber array 1301. Subsequently, at least one of the optical fiber array or one of the light emission portions is substantially aligned and/or overlapped with a corresponding light receiving element. Accordingly, the rejection set forth above is proper.

III) The brief, pages 11 and 12, argues that the Funada et al reference does disclose "the portions of EL light emitting elements 200 that emit light to document 400" (page 11 of the brief) but does not disclose at least the feature a light emission portion being substantially aligned with its corresponding light receiving element. This is found not persuasive because at least in Detailed

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Description of the Preferred Embodiments, column 6, lines 4-10, Funada reference does state that "The surface of the insulating substrate on which the light receiving elements are formed is coated with adhesive to bond the light receiving elements and the EL light emitting elements together so that light incident windows of the light receiving elements respectively align with light incident windows of the EL light emitting elements, which refers to at least one of the embodiments of the Funada et al invention, Fig. 9, column 12, lines 17-45, wherein the incident windows of the EL light emitting elements 200 formed by electrode(s) 241 (clearly seen in Fig. 11). Accordingly, the rejection set forth above is proper.

IV) The brief, on pages 12 and 13, respectively argues that when the Appellants' admitted prior art and/or Funada et al reference fail to teach or disclose the features of the based claimed invention, independent base claims 1 and 43, then the claimed invention of the dependent claims 2, 4-6, 47 and 51 would have not been obvious from Appellants' admitted prior art and/or Funada et al reference. This is found not persuasive because the Appellants' admitted prior art and the Funada et al reference does disclose all features of the independent base claims 1, 43 and 52. Accordingly, the rejection set forth above is proper.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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September 12, 2000



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